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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,698	12/22/2000	Clive C. Hayball	584-1038	9931

7590 11/16/2004  
Lee, Mann, Smith, McWilliams,  
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Chicago, IL 60690-2786

EXAMINER

HALIM, SAHERA

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/747,698

Applicant(s)

HAYBALL, CLIVE C.

Examiner

Sahera Halim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-13 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. Claims 1-13 have been presented for examination.
2. The applicant's attention is brought to having two claims 7. For examination purposes the first claim 7 remains claim 7 and the second claim 7 hereinafter is 7a. Appropriate correction is required.

### ***Election/Restrictions***

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

- I. Claims 1-5, and 7, 7a, 11 and 12 are drawn to a method of indexing content in an IP-based network comprising intercepting, extracting identity, generating and storing mapping, classified in Class 707, subclass 1.
- II. Claim 6, 8, and 13 are drawn to intercepting, sending an instance request, receiving an instance mapping, selecting the best instance of content, obtaining the requested content and returning the requested content, classified in Class 707, subclass 11.
- III. Claim 9 is drawn to advertising message for transmission over an IP-based network, the message being arranged to advertise a replica content item and a location for that item, classified in Class 705, subclass 14.
- IV claim 10 is drawn to an instant request for transmission over a network, the request including a destination address and the identity of a requested content item,

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the destination address being a different address to the address of the source location of the content item, classified in Class 709, subclass 200

4. Inventions I, and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, Invention I is a method of indexing content in an IP-based network comprising intercepting, extracting identity, generating and storing mapping, classified in Class 707, subclass 1. And, this combination, Invention II, as claimed does not require the particulars of the subcombination as claimed because the Invention II does not explicitly require advertising the content identities, calculating the time period and receiving an advertising message. The subcombination has separate utility such as selecting the best instance of the content from the list and obtaining the requested content from the location associated with the best instance of the requested content, classified in a different Class/Subclass.

See M.P.E.P. § 806.05(d).

Inventions I and II and III and IV are disclosed as different combinations, which are not connected is design, operation or effect. These combinations are independent if it can be shown that (1) they are not disclosed as capable of use together, (2) they have different modes of operation, (3) they have different functions, or (4) they have different effects (MPEP. 806.04, MPEP. 808.01). In the instant case, invention I and II are directed to intercepting a network flow, extracting content identity, generating and storing mapping. Invention III is directed to. Invention III is directed to drawn to advertising message for transmission over an IP-based network, the message being

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arranged to advertise a replica content item and invention IV is directed to an instant request for transmission over a network, the request including a destination address and the identity of a requested content item, the destination address being a different address to the address of the source location of the content item. Therefore, inventions I and II, III and IV have different functions and they have different effects.

5. These inventions are distinct for the reasons given above, and the search required for each Group is different and not co-extensive for examination purpose.

6. For example, the searches for the five inventions would not be co-extensive because these groups would require different searches on PTO's classification class and subclass as following:

(a) the Group I search (claims 1-5, 7, 7a, 11 and 12) would require use of search Class 707, subclass 1 (not required for the invention II, III and IV).

(b) the Group II search (claims 6, 8 and 13) would require use of search Class 707, subclasses 11 (not required for the invention I, III, and IV).

(c) the Group III search (claim 9) would require use of search Class 705, subclass 14 (not required for the invention I, II, and IV)

(b) the Group IV search (claim 10) would require use of search Class 709, subclass 2000 (not required for the invention I, III, and II).

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7. A telephone call was made to William M. Lee, Jr. on November 8, 2004 to request an oral election to the above restriction requirement, but did not result in an election being made.

8. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

10. A shortened statutory period for response to this action is set to **expire 1 (one) month and 0 (zero) days** from the mail date of this letter. Fail to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C. 133, M.P.E.P 710.02, 710.02(b)).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sahera Halim whose telephone number is (703) 305-8054. The examiner can normally be reached on M-F from 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (703) 308-7562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sahera Halim  
Patent Examiner

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November 9, 2004



SALEH NAJJAR  
PRIMARY EXAMINER